



Paper No. 11

SYMYX TECHNOLOGIES INC
LEGAL DEPARTMENT
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OFFICE OF PETITIONS

In re Application of	:
Boussie et al.	:
Application No. 09/854,128	: DECISION DISMISSING
Filed: 10 May, 2001	: PETITION
Attorney Docket No. 99-111CIP1	:

This is a decision in reference to the renewed petition filed on 13 June, 2002, requesting that the above identified application be accorded a filing date of 10 May, 2001, with two (2) sheets of drawings as a part of the original disclosure.

The petition is again dismissed.

The application was deposited on 10 May, 2001, without drawings. On 1 February, 2002, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application, stating that the application had been deposited without drawings, and that the filing date would be the date the drawings were received. A two (2)-month period for reply was set.

In response, on 28 February, 2002 (certificate of mailing date 13 February, 2002), petitioner filed a petition accompanied by two (2) sheets of drawings. Petitioners assert that the application, including two (2) sheets of drawings, is entitled to a filing date of 10 May, 2001, because the application claims the benefit of prior Application No. 09/567,598, filed on 10 May, 2000, which contains the two (2) drawing figures contained in the two (2) sheets of drawings filed with the present petition.

The petition was dismissed on 17 April, 2002. However, it was noted that the application as filed was entitled to a filing date of 10 May, 2001, because Claims 1-24 are method claims. As

stated in the decision mailed on 17 April, 2002, it has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).¹ Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as filed, is entitled to a filing date without the drawings.

On reconsideration, petitioners assert that the present application is a continuation-in-part of prior copending Application No. 09/567,598 filed on 10 May, 2000, which claims the benefit of Application No. 09/156,827, filed on 18 September, 1998, both of which are incorporated herein by reference. Based on the incorporation by reference, petitioners again request that the application be accorded a filing date of 10 May, 2001, with Figures 1 and 2 of the drawings as a part of the original disclosure.

The Office notes, upon further review, that Page 1 of the specification of the present application states:

This application claims the benefit under 35 USC 120 and is a continuation-in-part of co-pending U.S. Patent Application No. 09/567,590 filed May 10, 2000, which claims the benefit of U.S. Patent Application No. 09/156,827 filed September 18, 1998, both of which are incorporated herein by reference.

Section 201.06(c) of the Manual of Patent Examining Procedure states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.
(emphasis supplied)

¹MPEP 601.01(f).

Obviously, in view of the incorporation by reference of the prior application, the drawings of Figures 1 and 2 are not new matter if they was a part of the disclosure of the prior application.

Petitioners should file Figures 1 and 2 as a preliminary amendment. If Figures 1 and 2 are filed as an amendment, they will be reviewed by the Examiner for new matter.

The application will be processed and examined using only the application papers present on 10 May, 2001. The copies of Figures 1 and 2 supplied with the present petition will not be used for processing or examination, but will be retained in the application file.

The application is being forwarded to Technology Center 1600 for examination in due course.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6918.



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